

### **REMARKS**

The Applicants and the undersigned thank Examiner LeRoux for the careful review of this application. Consideration of the present application is respectfully requested in light of the above amendments to the claims, and in view of the following remarks.

Upon entry of this amendment, Claims 1-9, 11-14, 16, 18, 21, 22, and 27-41 remain pending in this application. The independent Claims pending in this application are Claims 1 and 29.

#### **Claim Rejections Under 35 U.S.C. § 112**

The Examiner rejected Claims 18 and 41 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has stated that Claims 18 and 41 recite the term "Gateway to Educational Materials," which the Examiner contends is a trademark or trade name. Applicant has amended claims 18 and 41 to replace the terms "Gateway to Educational Materials ("GEM")-approved" and "GEM-approved" to "pre-approved."

#### **Claim Rejections Under 35 U.S.C. § 102**

The Examiner rejected Claims 1, 2, 5, 7, 8, 11, 13, 21, 27, 29, 30, 33, 35 and 38 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,987,454 to Hobbs (the "Hobbs reference"). The Applicants respectfully offer remarks to traverse these pending rejections.

#### **Independent Claims 1 and 29**

##### **The Examiner Has Failed To Set Forth A Prima Facie Case Of Anticipation**

The Examiner rejects Claims 2, 5, 7, 8, 11, 13, 21, 27, 29, 30, 33, 35 and 38 as being anticipated by the disclosure of claim 29 of the Hobbs reference. The Applicants respectfully submit that the rejection is improper because the Examiner has failed to set forth a prima facie case of anticipation. Indeed, the Examiner has provided no analysis or argument to support this rejection and fails to even identify what portions of Hobbs' claim 29 are relevant to the Examiner's conclusion. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). “[T]o establish a prima facie case of anticipation the Office must show that . . . all the elements in the claims of the application are set forth, either explicitly or inherently, in the allegedly anticipating prior art reference.” In re Gately, 69 Fed.Appx. 993, 996 (Fed. Cir. 2003). In the present application, no such prima facie case has been set forth. Accordingly, Applicants request that the rejection of Claims 1 and 29 be withdrawn.

### **Hobbs Fails To Teach Or Suggest A User Determination Of Desirable Search Results**

As stated above, the Examiner has merely cited without analysis claim 29 of the Hobbs reference as anticipating Claims 1 and 29 of the present application. The Applicants respectfully submit that Hobbs’ claim 29 does not teach or suggest all of the recitations of Claims 1 or 29 of the present application. As an example, Hobbs’ claim 29 does not disclose a step of “presenting the test results to a user for a determination as to whether the test results are desirable.” Nor does Hobbs’ claim 29 disclose a step of “in response to the determination that the test search results are desirable, embedding a search link corresponding to the search parameters into the genesis document to create the embedded search link document.” The only user involvement disclosed in Hobbs’ claim 29 is that the user may select one out of a series of graphic symbols, where each symbol presumably representing one of several available forms of media or information associated with a particular term in a document (see, e.g., Figure 6B, elements 303 and 305).

In contrast, Claims 1 and 29 are directed to a method (Claim 1) and a system (Claim 29) for creating an embedded search link document. The embedded search link document generation of exemplary embodiments of the present invention permit “a user to create search links which, when accessed, initiate data queries in order to return information relevant to the subject of the queries.” (Specification, p. 11, ll. 24-26). During the creation of a search link document in exemplary embodiments of the present invention, the user may assess the results of a test search and tailor the embedding process to fit the desired linked content. The specification clearly supports the recitations of these claims:

Once the embedded search link document system 10 presents the user with a list of potential responses, the user may select preferred links from within the list, and may insert search links into the document as desired.

(Specification, p. 13, ll. 24-27; see also, p. 22, ll. 27-32). The portion of the specification directed to Figure 7 is further instructive:

In step 735, the embedded search link document generation system 10 presents the results of the search subroutine to the user. In the exemplary embodiment, the results are compiled into a results list and presented in a separate window on the display screen 47, although alternate embodiments may present results individually, or within the same window containing the curriculum standards document. Once the user receives the results list in step 735, step 740 is accessed.

In step 740, the embedded search link document generation system 10 awaits user selection of preferred links. A user may designate any or all of the links presented in the results list as a "preferred link." Preferred links differ from ordinary search results in two ways. First, preferred links are displayed at the top of any results list generated in response to an end user accessing a search link. Second, the document to which a preferred link leads is compressed and saved with the parent CSD [Curriculum Standards Document].

After step 740, step 745 is accessed. In step 745, the user may create a search link 360 embodying the search parameters shown in the search criteria dialogue 400. A user creates a search link in the exemplary embodiment by pressing the "insert link" button 460 in the search criteria dialogue 400. The embedded search link document generation system 10 inserts an HTML-formatted hyperlink in the CSD at the location of the cursor in the editing pane 310.

(Specification, p. 25, ll. 9-30). Because claim 29 of the Hobbs' reference does not teach or suggest a user determination of desirable search results, the Applicants respectfully request the withdrawal of the rejections of Claims 1 and 29.

The Applicants submit that the Examiner's failure to set forth a prima facie case for anticipation has prejudiced the Applicants' ability to fully respond to the anticipation rejection. Accordingly, the Applicants submit that there may be several other bases for traversing the anticipation rejection based on claim 29 of the Hobbs reference that are not set forth in this Response. However, while the Applicants consider the above remarks to be sufficient to traverse this rejection, the Applicants reserve all rights to raise other bases for traversing the anticipation rejection if and when the Examiner sets forth a prima facie case of anticipation.

**Dependent Claims 2-9, 11-14, 16, 18, 21, 22, 27, 28, and 30-41**

The Applicants respectfully submit that the above-identified dependent claims are allowable because the independent claim from which each depends is patentable over the cited references. The Applicants also respectfully submit that the recitations of these dependent claims are of patentable significance. In view of the foregoing, the Applicants respectfully request that the Examiner withdraw the pending rejections of Claims 2-9, 11-14, 16, 18, 21, 22, 27, 28, and 30-41.

**Claim Rejections Under 35 U.S.C. § 103**

The Examiner rejected Claims 9, 14, and 37 under 35 U.S.C. § 103 as being unpatentable over the Hobbs reference. The Examiner rejected Claims 3, 4, 6, 12, 28, 31, 32, 34, and 36 under 35 U.S.C. § 103 as being unpatentable over the Hobbs reference and in view of Publication No. US 2001/0044833 to Eisendrath et al. The Examiner rejected Claims 16 and 40 under 35 U.S.C. § 103 as being unpatentable over the Hobbs reference and in view of U.S. Patent No. 6,427,145 to Hara et al. The Examiner rejected Claims 22 and 39 under 35 U.S.C. § 103 as being unpatentable over the Hobbs reference and in view of U.S. Patent No. 5,321,833 to Chang et al. Because Claims 3, 4, 6, 9, 12, 14, 16, 22, 28, 31, 32, 34, 36, 37, 39, and 40 depend from Independent Claims 1 or 29, the Applicants respectfully submit that the dependent claims are allowable because the independent claim from which each depends is patentable over the cited references.

Each of the above-referenced obviousness rejections refers either directly or indirectly to the Examiner's arguments in connection with the anticipation rejections. As stated above, the anticipation rejections failed to set forth a prima facie case. For the reasons provided above in connection with Claims 1 and 29, the Applicant submits that the Examiner failed to set forth a prima facie case of obviousness.

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

- a. the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

- b. the difference or differences in the claim over the applied reference(s),
- c. the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- d. an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P. Section 706.02(j) (8th ed., Rev. 1, Feb. 2003).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 -§ 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

**It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.** M.P.E.P. Section 706.02(j) (8th ed., Rev. 1, Feb. 2003) (emphasis added). Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Id. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Id. Since patent examiners cannot normally be

compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application. Id.

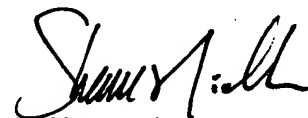
Because the Examiner has failed to set forth a prima facie case of obviousness, the Applicants respectfully request the withdrawal of the rejection of Claims 3, 4, 6, 9, 12, 14, 16, 22, 28, 31, 32, 34, 36, 37, 39, and 40.

### **Conclusion**

The foregoing is submitted as a full and complete response to the Office Action mailed on September 23, 2003. The Applicants and the undersigned thank Examiner LeRoux for consideration of these remarks. The Applicants have amended the claims and have submitted remarks to traverse rejections of Claims 1-9, 11-14, 16, 18, 21, 22 and 27-41. The Applicants respectfully submit that the present application is in condition for allowance. Such action is hereby courteously solicited.

If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any formalities that can be corrected by an Examiner's amendment, please contact the undersigned at (404) 572-3507.

Respectfully submitted,



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